

REMARKS

Claims 16 to 38 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 16 to 38 were rejected under 35 U.S.C § 103(a) as unpatentable over EP 1,111,753 to Koji et al., (“Koji”) in view of U.S. Publication No. 2003/107351 to Taniguchi et al., (“Taniguchi”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 16 relates to an electrical device for controlling a generator in an electrical system of a motor vehicle, in which the controller provides a **first area of operation** ... in which a voltage control is performed to regulate the generator voltage, to the **exclusion of performing a torque control to regulate a braking torque exerted by the generator**, and at least one **second area of operation** based ... in which the **torque control** is performed, to

the exclusion of performing the voltage control, the controller transitioning from the first area to the at least one second area when the generator voltage goes beyond one of a first upper threshold value and a first lower threshold value, in which the first upper threshold value and the first lower threshold value is defined by a boundary of the first area.

The Final Office Action (at paragraph 22 on page 9) conclusorily asserts that the areas of operation are not structural limitations and that the areas of operation are a result of operation of the claimed subject matter.

It is respectfully submitted that the areas of operation are not a result but instead define the controller (a structural element) in terms of its function. MPEP 2173.05(g) specifically states that “There is nothing inherently wrong with defining some part of an invention in functional terms.” Further, the Federal Circuit has recognized that limitations such as “members adapted to be positioned” and “portions . . . being resiliently dilatable whereby said housing may be slidably positioned” serve to precisely *define present structural attributes of interrelated component parts* of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

In the context of the presently claimed subject matter, the areas of operation specify a predetermined response of the controller in relation to the status of the generator. Accordingly, the claim 16 features relating to the areas of operation should be treated as defining structural features of the controller.

The Final Office Action agrees that merely combining Koji and Taniguchi is insufficient to disclose an identical controller, but unsupportedly and conclusorily asserts that the operational behavior of the controller is somehow obvious. As explained above, however, the Office (under *KSR*) must provide a reason to support any conclusion that one of ordinary skill in the art would combine the prior art elements in the manner claimed.

As further regards the obviousness rejection of the claim 16, the Final Office Action has not made any findings regarding what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (*See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the

problem to be solved as a whole would have suggested to those of ordinary skill in the art,” and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone,” as here. (*See In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art,” the “level of ordinary skill in the art” or “the nature of the problem to be solved”))).

The Final Office Action does not provide any of the necessary findings, as explained above. The Final Office Action makes only conclusorily assertions as to the areas of operation, as provided for in the context of the presently claimed subject matter.

For example, the Office Action merely concludes--without any evidentiary support--that it would have been obvious to graphically arrange operational parameters so as to define the areas of operation. Still further, paragraph 21 merely conclusorily asserts that “one with ordinary skill in the art would develop and design a control architecture to perform a plurality of independent control strategies which could result in the claimed control results, given a predetermined set of control parameters to be controlled.” Not only is this unclear as to what parameters are being controlled, no explanation is provided as to why the claimed features fall within a “control strategy” that is within the level of one of ordinary skill in the art.

Accordingly, the Final Office Action does not properly set forth the elements of a *prima facie* case of obviousness as to claim 16.

With respect to paragraph 24 on page 10 of the Final Office Action, any previous arguments relating to the control concept of the claimed subject matter were not intended to supplement or modify any recited claim features. Instead, reasons were detailed that supported a finding of non-obviousness, including, for example, the fact that the areas of operation are not an obvious design choice or configuration.

Accordingly, it is respectfully requested that the Office take these reasons into consideration in performing an obviousness analysis of the claims.

Finally, the present lack of any of the required factual findings forces Applicants and any Appeals Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (*See In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q.

Application Serial No. 10/582,926
Atty. Docket No. 10191/4796
Reply to Final Office Action of September 17, 2010

785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Office bears the initial burden of presenting a proper prima facie unpatentability case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

In view of all the foregoing, claim 16 is allowable, as are its dependent claims 17 to 24, 31 to 34, 37, and 38.

Claim 25 includes subject matter like that of claim 16 and it is therefore allowable for essentially the same reasons, as are its dependent claims 26 to 30, 35, and 36.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Office Action provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Office Action provide an affidavit and/or that the Office Action provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Office Action, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Withdrawal of the obviousness rejections is therefore respectfully requested.

In sum, claims 16 to 38 are allowable.

CONCLUSION

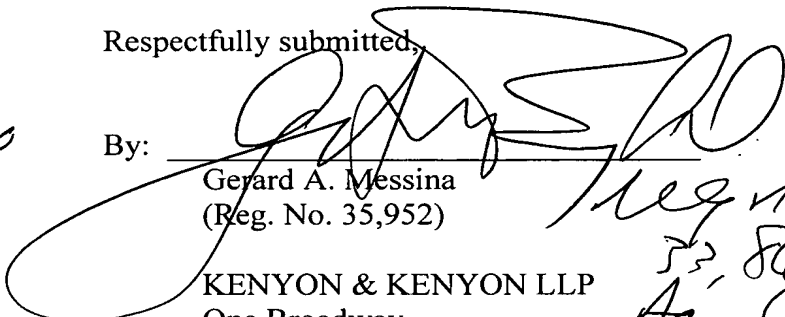
In view of the foregoing, it is respectfully submitted that all of presently pending claims 16 to 38 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Since all issues raised by the Office Action have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

Dated: _____

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